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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,057	06/06/2001	Takehiro Nishiyama	209396US-2X	5638
22850	7590	09/28/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			RUHL, DENNIS WILLIAM	
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ALEXANDRIA, VA 22314			PAPER NUMBER	

3629

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/874,057

**Applicant(s)**

NISHIYAMA, TAKEHIRO

**Examiner**

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005 and 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/2/05 has been entered. The subsequent submission of 7/14/05 has also been entered. Applicant has canceled claims 1-16 and currently claims 17-22 are pending. Applicant should take notice that the examiner has interpreted the claims in two manners, one under section 102 and the other under 103.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Janssen (5754850).

For claims 17,18,20,21, Janssen discloses a system and method that relates to *"the field of computer search methods. More particularly the present invention relates to a method and apparatus for searching a database for items satisfying specific features or closely satisfying specific features."* (See the Field of the Invention section of Janssen). Janssen also discloses in column 8, lines 48-54, that the method is contemplated as being performed "on-line" and can be used for purposes other than

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real estate such as finding a lawyer, finding a loan, or finding an apartment. The examiner takes notice that apartments are an item that is well known as being rented. Janssen recognizes the use of the system and method for apartments, which are rentals. Janssen discloses that the information about available items (items for sale or rent or services available for hire, whatever the intended use of the system is) is downloaded to a computer by using a modem 270. See figure 2 and column 4, lines 10-11. This inherently requires the use of a first terminal as claimed and satisfies the functional language relating to the 1<sup>st</sup> terminal. One must necessarily have a first terminal that communicates with modem 270 to update the information on file. The 2<sup>nd</sup> terminal is also considered inherent because Janssen discloses that the invention can be done "on-line". This requires that the customer desiring a rental has a 2<sup>nd</sup> terminal that they use to submit the search query describing what they want as far as a rental goes. The network server is 200 and the means for holding data is database 210. The database 210 holds data relating to whatever the system is being used for. This includes data such as specification (kind of apartment, 1 bedroom, 2 bedroom, etc.); location; and time period (when is apartment needed or how long of a lease is desired?). This kind of information necessarily is involved in the rental process for apartments. If apartments are listed the data will include the kind of apartment, location, and availability. The "means for searching" is the software disclosed in column 4, lines 2-4. The means for providing a searched result is present in Janssen because it is disclosed that the results are given to the customer. After all that is the reason you are using the system anyway, to get results to your search. In Janssen it is disclosed that

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the user can specify certain search criteria as being primary and others as non-primary. This satisfies the claimed limitation of having an option that allows the identification of a preferred option for one of the search criteria. Janssen discloses this feature. Janssen searches for the primary features first and will then search the results for the non-preferred options. With respect to the fact that the claims are reciting that the system is for the renting of a construction machine, this is directed to the intended use of the system and must result in a structural difference when compared to the prior art. In this case there is no difference between the prior art. The fact that the data for location, specification and time period are intended for or describe construction machines does not define over the same kind of data that would be used for apartments. The data involved in construction machines and apartments is the same, namely, location, specification (kind of apartment), and time period. The fact that the data is relating to construction machines is not important because the data variables themselves are disclosed in Janssen. Additionally, the language "configured to enable" is very broad and is really just claiming the terminal that is capable of allowing input of data and is not claiming the data as being stored in a positive sense. Any computer with an input device such as a keyboard is capable of inputting any kind of information you desire.

With respect to the limitations directed to the data that is able to be inputted into the system and searched by the system, the examiner has two comments. The first is that the language "configured to enable" only means that the terminals must be capable of allowing one to enter data. This does not mean or require the claimed type of data. The data is just the intended use of the system. Second comment is that data is data,

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and claiming that certain data that represents construction machines is being searched or is able to be inputted is not defining anything further to the system.

For claim 19, reciting what the machine is that is for rent defines nothing further to the claimed system. The kind of machine is directly related to the intended use of the system and what the item is that is being rented. Janssen satisfies what is claimed because this claim defines nothing further to the system of claim 17.

For claim 22, this claim is reciting more of a method of use limitation and does not define any further structure to the system of claim 17. This claim is directed to the intended manner of use for the invention.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen (5754850) in view of the newswire article of 2-3-2000 "United Rentals, Inc. Launches Business to Business Equipment E-Rental Store". In this rejection the examiner is giving more weight to the intended use of the system than in the 102 rejections to more fully address the actual intended use recited.

For claims 17,21, Janssen discloses a system and method that relates to "*the field of computer search methods. More particularly the present invention relates to a*

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*method and apparatus for searching a database for items satisfying specific features or closely satisfying specific features.”* (See the Field of the Invention section of Janssen).

Janssen also discloses in column 8, lines 48-54, that the method is contemplated as being performed “on-line” and can be used for purposes other than real estate such as finding a lawyer, finding a loan, or finding an apartment. The examiner takes notice that apartments are an item that is well known as being rented. Janssen recognizes the use of the system and method for apartments, which are rentals. Janssen discloses that the information about available items (items for sale or rent or services available for hire, whatever the intended use of the system is) is downloaded to a computer by using a modem 270. See figure 2 and column 4, lines 10-11. This inherently requires the use of a first terminal as claimed and satisfies the functional language relating to the 1<sup>st</sup> terminal. One must necessarily have a first terminal that communicates with modem 270 to update the information on file. The 2<sup>nd</sup> terminal is also considered inherent because Janssen discloses that the invention can be done “on-line”. This requires that the customer desiring a rental has a 2<sup>nd</sup> terminal that they use to submit the search query describing what they want as far as a rental goes. The network server is 200 and the means for holding data is database 210. The database 210 holds data relating to whatever the system is being used for. This includes data such as specification (kind of apartment, 1 bedroom, 2 bedroom, etc.); location; and time period (when is apartment needed or how long of a lease is desired?). This kind of information necessarily is involved in the rental process for apartments. If apartments are listed the data will include the kind of apartment, location, and availability. The “means for searching” is

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the software disclosed in column 4, lines 2-4. The means for providing a searched result is present in Janssen because it is disclosed that the results are given to the customer. After all that is the reason you are using the system anyway, to get results to your search. In Janssen it is disclosed that the user can specify certain search criteria as being primary and others as non-primary. This satisfies the claimed limitation of having an option that allows the identification of a preferred option for one of the search criteria. Janssen discloses this feature. Janssen searches for the primary features first and will then search the results for the non-preferred options.

Not disclosed in Janssen is that the system and method is used renting of construction machines.

The newswire article discloses that United Rentals has opened on "on-line" E rental store for renting of equipment such as construction equipment, heavy machinery, and other types of equipment. Because Janssen discloses that the system and method can be used for things such as searches for *"home loans, schools, doctors, cars, apartments, vacation packages, lawyers, and CPA's"* and the system can also be used "on-line", it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of Janssen for the rentals of equipment such as construction equipment and machines, as the newswire article discloses. The system of Janssen can be used for any kind of activity where searching for something is involved. One of ordinary skill in the art would find the use of Janssen obvious for construction machines in view of the fact that United Rentals is renting equipment "on-



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line". The intended use of the system is a choice that is obvious to one of ordinary skill in the art.

For claim 18, Janssen discloses upper location information which is the entered zip code. This defines an area or a location. The lower location information is a location such as "near the ocean" or "walking distance to public transportation". These are both locations within the more broad location defined by the zip code. In Janssen the zip code is a preferred search term (primary) and the features such as being near the ocean or near public transportation are disclosed as being non-preferred search criteria. Janssen searches as has been claimed.

With respect to claim 19, the recitation that the machine is a tracklaying machine is defining nothing further to the system and is satisfied by Janssen. The construction machine is what is being rented and is not part of the system. At best, this limitation is non-functional descriptive material that just describes what the item is that is being rented. Additionally, when one is using the system of Janssen for the rental of construction equipment as the 103 rejection does, one of ordinary skill in the art would appreciate that this includes machines such as a tracklaying machines.

For claim 20, Janssen discloses what is claimed because the information about what is available (specification information) can be searched as claimed. The user can specify that they are looking for an apartment (upper class), and then further specify that they want a two-bedroom apartment (lower class). This is information in hierarchal form. This satisfies what is claimed. The language about the data defining something

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that is easy to change or not easy to change is just descriptive about the data itself and gets minimal weight.

For claim 22, not disclosed is that the information is presented in the form of a calendar but the results of the search are provided to the customer is a format. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the results of the search in the form of a calendar so that a customer can view when machines are available for rent. A calendar is the customary manner in which people schedule things and is an easy to understand type of format for the customer, especially when dates are involved.

5. Applicant's arguments with respect to claims 17-22 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**DENNIS RUHL**  
**PRIMARY EXAMINER**